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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/141,318 | 08/27/1998 | HIROSHI ISOMURA | 1046.1190/J | 9722 |
| 21171 | 7590 | 06/17/2004 | | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | | |
| | | | EXAMINER ENG, GEORGE | |
| | | | ART UNIT 2643 | PAPER NUMBER 23 |

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/141,318

Applicant(s)

ISOMURA, HIROSHI

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,12-17,20-24,27-31 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12-17,20-24,27-31 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/2003 (paper no. 19) has been entered.

Response to Amendment

2. This Office action is in response to amendment filed 3/23/2004 (paper no. 22).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, 12-17, 20-24, 27-31 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsiao (US PAT. 5,848,137) in view of Uchida et al. (JP 06290121A hereinafter Uchida) and Horiuchi et al. (US PAT. 6,272,530 hereinafter Horiuchi).

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Regarding claim 1, Hsiao discloses a telephone with an electronic mail managing function capable of connecting with at least a mail server and a computer as shown in figure 1 comprising access means (34) for accessing to the mail server (col. 4 lines 3-4 and lines 43-45), a mail memory (90) for storing an electronic mail which is sent to one user downloaded from the mail server through the access means (col. 4 lines 5-8), transmission means for transmitting the electronic mail stored in the mail memory to the computer (col. 4 lines 17-19), wherein the electronic mail managing function is provided logically between the mail server and the computer (col. 5 lines 26-35 and col. 7 lines 6-15). Hsiao differs from the claimed invention in not specifically teaching that each states stored in the status memory indicating whether or not the electronic mail is downloaded to each of the electronic devices from the telephone. However, Uchida teaches an electronic mail system to improve the receiving/transmitting operability by registering the attributes of reception/transmission of electronic mails, state indicating whether or not the electronic mail has been transmitted or received, in a register list so that the attributes of the electronic mail can be referred to and applied after reception/transmission of the mails (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hsiao in having each states stored in the status memory indicating whether or not the electronic mail is downloaded to each of the electronic devices from the telephone, as per teaching of Uchida, in order to improve the receiving/transmitting operability. Furthermore, neither Hsiao nor Uchida teaches the telephone with the electronic mail managing function connecting with a plurality of terminal device and having a mail status memory for storing each state of the electronic mail stored in the memory in order to manage the electronic mail based in the status of the electronic mail corresponding to each of the terminal

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devices. However, Horiuchi teaches transmitter and receiver (101 and 103) for an electronic mail system capable of connecting with a plurality of terminals (figure 1 and col. 2 line 62 through col. 3 line 29) comprising a status memory (405) for storing each status of the electronic mail as shown in figure 7 and a mail managing function managing the electronic mail based on the status of the electronic mail corresponding to each of the terminal (col. 5 lines 12-67). By combining the combination of Hsiao and Uchida with Horiuchi, the electronic mail will retain in the memory if a user hasn't read the mail properly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Hsiao and Uchida in having the electronic mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each terminal, as per teaching of Horiuchi, because it improves the telephone capable of retaining the electronic mail when the user has not yet read the electronic mail properly.

Regarding claim 3, Horiuchi teaches a process table for storing a process to be applied to the electronic mail after the electronic mail is downloaded to each of the terminal devices (figure 7 and col. 5 lines 13-16).

Regarding claim 4, Horiuchi teaches the process to be applied to the electronic mail including deleting the electronic mail and keeping the electronic mail (col. 5 lines 48-56).

Regarding claim 5, Horiuchi teaches emergency process means (105) for judging whether or not a priority is necessary based on the electronic mail received from each of the terminal devices (col. 6 lines 5-18).

Regarding claim 6, Horiuchi teaches an identifier memory for storing an identifier of a terminal device to be connected, and permitting an access from the terminal device in case that the identifier coincides with the stored identifier (col. 4 lines 24-30).

Regarding claim 7, Hsiao teaches a mail managing method in a mail managing apparatus as shown in figure 1 capable of transmitting and receiving mail data to and from at least a mail server and a terminal device, the method comprising a reading process of reading mail which is sent to a user stored in the mail server (col. 4 lines 3-4 and lines 43-45), a storing process of storing the mail read in the reading process (col. 4 lines 5-8), a display process of displaying a status of the mail stored in the storing process for the terminal device (figure 3), and a transmitting process of transmitting the mail stored in the storing process to the terminal device (col. 4 lines 17-19), wherein the electronic mail managing function is provided logically between the mail server and the computer (col. 5 lines 26-35 and col. 7 lines 6-15). Hsiao differs from the claimed invention in not specifically teaching that each states stored in the status memory indicating whether or not the electronic mail is downloaded to each of the electronic devices from the telephone. However, Uchida teaches an electronic mail system to improve the receiving/transmitting operability by registering the attributes of reception/transmission of electronic mails, state indicating whether or not the electronic mail has been transmitted or received, in a register list so that the attributes of the electronic mail can be referred to and applied after reception/transmission of the mails (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hsiao in having each states stored in the status memory indicating whether or not the electronic mail is downloaded to each of the electronic devices from the telephone, as per teaching of Uchida, in order to improve the receiving/transmitting operability. Furthermore neither Hsiao nor Uchida specifically teaching to manage the electronic mail based in the status of the electronic mail corresponding to each of the terminal devices. However, Horiuchi teaches transmitter and receiver (101 and 103) for an electronic mail system capable of connecting with a plurality of terminals (figure 1 and col. 2 line 62 through col. 3 line 29) comprising a status memory (405) for storing each state after the electronic mail downloaded to each of the electronic devices as

shown in figure 7 and a mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each of the terminal (col. 5 lines 12-67). By combining the combination of Hsiao and Uchida with Horiuchi, the electronic mail will retain in the memory if a user hasn't read the mail properly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hsiao in having the electronic mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each terminal, as per teaching of Horiuchi, because it improves the telephone capable of retaining the electronic mail when the user has not yet read the electronic mail properly.

Regarding claims 8-9, the limitations of the claims are rejected as the same reasons set forth in claim 7.

Regarding claim 12, Horiuchi teaches process specifying means for specifying how the electronic mail transmitted to the terminal device should be process for each terminal device (col. 3 lines 30-49).

Regarding claim 13, Hsiao teaches the electronic mail apparatus further comprising means for receiving the electronic mail from each terminal device and means for transmitting the received electronic mail to the mail server (col. 5 lines 17-25).

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 16, Hsiao teaches the electronic mail managing apparatus provided in a telephone (figure 1).

Regarding claims 17, 24 and 31, the limitations of the claims are rejected as the same reasons set forth in claim 9.

Regarding claims 20, 27 and 34, the limitations of the claims are rejected as the same reasons set forth in claim 12.

Regarding claims 21, 28 and 35, the limitations of the claims are rejected as the same reasons set forth in claim 13.

Regarding claims 22, 29 and 36, the limitations of the claims are rejected as the same reasons set forth in claim 5.

Regarding claim 23, 30 and 37, the limitations of the claims are rejected as the same reasons set forth in claim 6.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 16.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 3-9, 12-17, 20-24, 27-31 and 34-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miyake (JP 10011376A) discloses an electronic mail system to recognize a mail which is already read by a user in a certain terminal in another terminal as a read mail (abstract). Kawanaka (US PAT. 6,351,763) discloses an electronic mail system comprising a sever on a receiving side capable of re-transmit a saved electronic mail to a receiver in response to a status that the saved electronic mail has been deleted (abstract).

7. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

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Or faxed to:

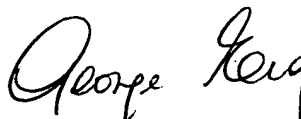
(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, V.A., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng
Primary Examiner
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